

Appl. No. 10/776,851
Docket No. CM2687MQ
Amdt. dated October 23, 2006
Reply to Office Action mailed on May 25, 2006
Customer No. 27752

REMARKS

Specification Status

The specification has been amended to correct typographical errors. Support for the change may be found on page 17, lines 5 – 10 of the specification. These changes do not involve any introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested.

Claim Status

Claims 1 - 20 are pending in the present application. No additional claims fee is believed to be due.

New claims 13 and 20 have been added. Support for this amendment can be found at page 9, lines 16 – 17.

New claims 14, 15, 16, 17, 18 and 19 have been added. Support for this amendment can be found at claims 8, 10, 11, 2, 5 and 3, respectively.

Rejection Under 35 USC §103(a) Over Tanzer

Claims 1 – 12 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Tanzer, *et al.*, (U.S. Pat. No. 5,425,725) (Hereinafter “Tanzer”). Applicants respectfully traverse the rejection.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings. *In re Fritch*, 972 F.2d 1260 (Fed. Cir. 1992); MPEP § 2143.01. Second, there must be a reasonable expectation of success. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991); MPEP § 2143.02. Third, the prior art reference or combined references must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981 (CCPA 1974); MPEP §2143.03.

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The Office Action states

Regarding claim 1, Tanzer, et al. teach an absorbent core (112, 120) useful for an absorbent article comprising a substrate layer (98) and absorbent material (110), said absorbent material (110) comprising an absorbent polymer material . . . wherein said absorbent material (110) is immobilized (trapped in pocket regions (108)) when wet such that said absorbent core (112, 120) achieves a wet immobilization.

(See the Office Action dated May 25, 2006, bottom of page 2 – top of page 3). Applicants respectfully disagree with the Office's reading of Tanzer. Specifically, Applicants submit that Tanzer does not disclose absorbent material being immobilized when the absorbent material is wet.

Applicants remind the Office that independent claim 1 includes the features of an absorbent core useful for an absorbent article comprising a substrate layer and absorbent material, said absorbent material comprising an absorbent polymer material and optionally an absorbent fibrous material, said absorbent fibrous material not representing more than about 20% of the weight of absorbent polymer material, wherein said absorbent material is immobilized when wet such that said absorbent core achieves a wet immobilization of more than about 50% according to the Wet Immobilization Test. (See claim 1 of the present application; emphasis added).

"Office Personnel must rely on the applicant's disclosure to properly determine the meaning of ** the claims." (MPEP quoting *Markman v. Westview Instruments*, 52 F.3d 967, 980, 34 USPQ2d 1321, 1330 (Fed. Cir.)). Applicants respectfully submit that the term "wet," being a relative term, must be read in light of the Specification of the present application.

The present application states "In accordance with the present invention, the absorbent material is **immobilized when wet** such that the absorbent core achieves a wet immobilization of more than 50% . . . according to the wet immobilization test described herein." (The present application, page 8, lines 12 – 14, emphasis added). The present application also states "the thermoplastic materials disclosed herein provide a much improved wet immobilization (*i.e.*, immobilization of absorbent material when the article

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is wet or at least partially loaded)” (The present application, page 9, lines 16 – 17). Thus, it can be seen that the term wet should be properly construed in the context of the Wet Immobilization test.

In order to properly construe claim 1 with regard to the term wet, Applicants direct the Office’s attention to the Wet Immobilization test, which begins at page 16, line 9 of the present application. The present application states “[the] [a]mount of test solution should be 50% of the laminate design capacity” (The present application, page 17, lines 5 – 6). The laminate design capacity is essentially the amount of liquid solution the laminate can store, and can be calculated by multiplying the mass of aqueous gelling material (AGM) in the laminate by the CRC capacity of the AGM in the laminate. (The present application, page 18, lines 5 – 11). Further, the present application discloses that the test solution should be given a five minute dwell time before executing the remainder of the test. (Page 17, line 9 of the present application, emphasis added). Still further, the present application discloses that the test solution may be saline. (Page 16, line 11 of the present application).

With regard to the term wet, Tanzer states “[s]amples were tested ‘dry’ or ‘wet’ with distilled water or . . . saline solution . . . as indicated in the table below.” (Tanzer, col. 37, lines 45 – 47, emphasis added). In stark contrast to the amount of solution added to the absorbent material in the Wet Immobilization test, Tanzer states “the wet and saline samples were . . . sprayed with the water or saline (1 to 3 grams) using a hand-held spray bottle.” (Tanzer, col. 37, lines 47 – 51, emphasis added). Further, Tanzer waits only thirty seconds after the last spray before performing the remainder of the test, as opposed to the five minute dwell time recited in the Wet Immobilization test of the present application.

Exemplary embodiments of an absorbent laminate according to Tanzer are disclosed in examples 57, 58 and 61, all of which are considered to be wet. (Tanzer, col. 43, lines 53 – 54). Examples 57, 58 and 61 all indicate delamination of the absorbent laminate. (See the table in col. 43 of Tanzer). Thus, the exemplary embodiments of Tanzer delaminate after the addition of only 1 – 3 grams of water or saline. Applicants

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respectfully submit that if the exemplary embodiments of Tanzer were exposed to the amounts of water or saline recited in the Wet Immobilization test of the present application, the absorbent laminate of Tanzer would delaminate. Applicants further submit that upon waiting five minutes after the addition of such liquid when the absorbent laminate is placed on a diaper shaker, it is not unreasonable to conclude that Tanzer would exhibit minimal or no Wet Immobilization, as is recited in claim 1 of the present invention.

In further support of Applicants' assertion that the term wet as used in Tanzer is distinguishable from the use of "wet" in the present application, Applicants point to an embodiment disclosed in Tanzer wherein "the absorbent structure has an absorbent capacity of at least about 100 gm of saline." (Tanzer, col. 12, lines 36 - 38). Therefore, in order to disclose an absorbent core that achieves more than about 50% wet immobilization when wet, such as the absorbent core in claim 1 of the present application, the absorbent core of Tanzer would need to have 50 g of saline applied to it (50 g being 50% of the core's absorbent capacity). After the 50 g of saline was applied, the absorbent core of Tanzer would then need five minutes of dwell time. Once these steps were concluded, the absorbent core of Tanzer could be considered wet, as recited in claim 1 of the present invention. As pointed out above, if 1 - 3 grams of water or saline will cause delamination, then it follows that 50 g of saline would also cause delamination. Once the absorbent structure of Tanzer delaminates, the absorbent polymer material is free to migrate throughout the core. Free migration of the absorbent polymer material through the core after the core is wet is completely contrary to the concept of wet immobilization, as recited in claim 1 of the present application.

Thus, it is clear that Tanzer uses the term wet to define an absorbent laminate or structure that has even a minimal amount of water or saline added thereto. Claim 1 of the present application, when read in light of the Specification, clearly requires more than the addition of a mere 1 - 3 grams of water or saline before the absorbent material is to be considered wet. Therefore, Applicants respectfully submit that Tanzer does not teach or suggest each and every element of claim 1 of the present application.

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Even assuming, *arguendo*, that Tanzer does provide the requisite teaching or suggestion required to make a *prima facie* case of obviousness, there is still no motivation for one of ordinary skill in the art to modify Tanzer in order to provide the absorbent article of claim 1. "A *prima facie* case of obviousness may also be rebutted by showing that the art, in any material respect, teaches away from the claimed invention." *In re Giesler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997). Applicants assert that Tanzer clearly teaches away from the recitals of claim 1 of the present application.

It is well established by case law that

A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant . . . [or] if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by the applicant.

Tec Air, Inc. v. Denso Mfg. Mich., Inc., 192 F.3d 1353, 1360 (Fed. Cir. 1999). In addition, case law clearly states "[i]t is impermissible within the framework of §103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art." *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 448 (Fed. Cir. 1986).

Tanzer discloses an absorbent laminate having an attachment system (adhesive 102) that exhibits a wet strength that is less than the separating force imparted by the swelling of the high absorbency material when the high absorbency material is exposed to aqueous liquids, such as urine. (Tanzer, col. 14, lines 43-51). When the attachment system releases upon exertion of a separating force imparted by the swelling of the high absorbency material, the pockets (108) open thereby releasing the high absorbency material (110). In several other passages, Tanzer restates that the attachment system releases at an applied load which is less than the load needed to burst or tear either carrier layers. (See Tanzer, col. 14, lines 57-61; col. 16, lines 29-34; col. 17, lines 57-62). As pointed out above, Tanzer discloses that even a minimal amount of liquid may cause the

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delamination of the absorbent laminate thereby releasing the high absorbency material to migrate throughout the absorbent core or laminate.

In light of the above remarks, Applicants respectfully submit that the Office has selectively chosen portions of Tanzer without a full appreciation of the teachings away from Applicants' claimed invention. It is Applicants' position that such teachings away would discourage one of ordinary skill in the art from following the path set out in Tanzer to provide the absorbent core of claim 1 of the present application because to do so is contrary to improved wet immobilization.

Notwithstanding the above failings of Tanzer to make obvious the claims of the present application, Applicants further assert that one of ordinary skill in art could not reasonably modify Tanzer to provide the absorbent core of claim 1 of the present application. Case law provides that "[i]f the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." MPEP § 2143.01 (citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)). When considering the complete teachings of Tanzer, it is clear that the attachment system is designed to release upon exertion of a swelling force from the wetted high absorbency material. (Tanzer, col. 14, lines 57-61; Tanzer, col. 14, lines 57-62).

Improving the wet immobilization, as recited in claim 1 of the present application, would dictate that the attachment system *not* release upon exertion of a swelling force. Such a modification would render the absorbent laminate structure of Tanzer unsatisfactory for its intended purpose (*i.e.*, the water-sensitive attachment system is configured to release at an applied load which is less than the load needed to delaminate the water-sensitive attaching means without excessively tearing the material forming either or both of the carrier layers when such layers are wetted).

In addition to the lack of teaching or suggestion in Tanzer and the lack of motivation in Tanzer, the Office's reliance on "optimization of ranges" is misplaced and clouds the ultimate legal issue of obviousness. The Court of Customs and Patent Appeals

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has stated, "The problem, however, with such 'rules of patentability' (and the ever-lengthening list of exceptions which they engender) is that they tend to becloud the ultimate legal issue--obviousness--and exalt the formal exercise of squeezing new factual situations into preestablished pigeonholes." *In re Yates*, 663 F.2d 1054, 1056, 211 U.S.P.Q.2d 1149, 1151 n.4 (C.C.P.A. 1981). Thus, while the Office may perceive "optimization of ranges" as a *per se* basis for an obviousness determination, "optimization of ranges" is merely an attempt to squeeze the facts of the present application into a preestablished pigeonhole rather than conduct a thorough obviousness determination.

The Office cites *In re Aller* in support of the premise that it is not inventive to discover the optimum or workable ranges by routine experimentation. (The Office Action dated 5/25/2006, page 3, first full paragraph; *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955)). The Office Action also cites *In re Antonie* for the premise that a parameter must first be recognized as a results-effective variable before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation. (The Office Action, page 3, last paragraph to top of page 4; *In re Antonie*, 559 F.2d 618, 195 U.S.P.Q. 6 (C.C.P.A. 1977)).

Applicants assert that reliance on *In re Aller* is in error, and that the Office has failed to adequately recognize whether "wet immobilization" is a results-effective variable. Applicants point out that *Aller* states "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). It is Applicants' position that Tanzer does not disclose the general conditions of Applicants' claim.

To evaluate the "general conditions" of a claim, the Office must first construe the claim correctly. In addition to the remarks made above with regard to the term wet, Applicants also assert that likewise "wet immobilization" is misconstrued by the Office Action. Wet immobilization is a quantifiable value calculated from the Wet Immobilization Test described in the application. Wet immobilization is the weight

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percent of the wetted, swollen core remaining after being shaken by the "diaper shaker," which is described on pages 16 – 17 of the present application. As pointed out above, Tanzer provides no teaching or suggestion of "wet" when the term is reasonably construed, and so it follows, based on a statement made in the Office Action, that Tanzer also provides no teaching or suggestion of "wet immobilization" when the term is reasonably construed. See the Office Action, page 5, last paragraph, ("Tanzer *et al.* teaches pockets that maintain the location of superabsorbent material when the article is *wetted*").

As pointed out above, when the absorbent core or laminate of Tanzer is wetted, as recited in claim 1 of the present application, delamination will result, thereby allowing the absorbent polymer material to migrate freely throughout the absorbent core or laminate. Consequently, Applicants assert that because the absorbent core or laminate of Tanzer, when wetted according to claim 1 of the present application, will not provide wet immobilization, as recited in claim 1 of the present application, Tanzer does not disclose the general conditions of claim 1, as required by *Aller. Id.* As a result, Applicants respectfully submit that the Office's reliance on *Aller* is improper, and that the Office has failed to show that wet immobilization is a results effective variable under *Aller. Id.* Because there has been no proper showing that wet immobilization is a results effective variable then there can be no determination of optimum or workable ranges under *In re Antonie. In re Antonie*, 559 F.2d 618, 195 U.S.P.Q. 6 (C.C.P.A. 1977)). Thus, the Office has not properly shown the wet immobilization is a results-effective variable or that claim 1 of the present application merely recites the optimum or workable ranges of a results-effective variable. Accordingly, Applicants respectfully submit that the Office's assertion that claim 1 recites the optimization of a results-effective variable is improper.

Additionally, Applicants point out that the Office Action correctly states that a results-effective variable is "a variable which achieves a recognized result." (The Office Action dated 5/25/2006, page 4, first paragraph). However, the Office provides circular reasoning as support for the determination that "wet immobilization" is a results-effective variable. The Office states, "One of ordinary skill in the art would have recognized that

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increasing the wet immobilization properties of the absorbent material in a diaper or similar article would increase its resistance to moving around between top and back sheets and would prevent the absorbent from bunching up uncomfortably." However, the phrase "resistance to moving around between top and back sheets" appears to be nothing more than a definition of the term "immobilization". In other words, the Office argues that one of ordinary skill in the art would have recognized that increasing the wet immobilization properties of the absorbent material in a diaper or similar article would increase its "*immobilization*". Applicant contends that such reasoning does not support the conclusion that "wet immobilization" is a results-effective variable.

Furthermore, even if the Office is correct in classifying Applicants' "wet immobilization of more than about 50% according to the Wet Immobilization Test" as an optimizable results-effective variable, the Office fails to appreciate that sufficient evidence exists in the application as to the criticality of wet immobilization. Applicants, within the Background of the present application, have described some existing core structures. One such core structure described in U.S. Pat. No. 5,411,497 to Tanzer et al. (hereafter referred to as "Tanzer II") is specifically discussed on page 2, lines 9-21. The deficiency in Tanzer II is the ability to maintain wet immobilization. Given the existing discussion in the application, Applicants assert that ample evidence exists supporting the criticality of wet immobilization.

With regard to claims 2, 4-6, and 8-11; these claims are dependent from and contain all the limitations of claim 1. Tanzer fails to teach or suggest each and every limitation of claim 1. Therefore, claims 2, 4-6, and 8-11, which include all the limitations of claim 1, are patentably distinct over Tanzer.

With regard to Claim 3, the Office Action states "Tanzer et al. teach that the thermoplastic material (100) is a hot melt adhesive (Col. 13, lines 1-8)." However, Tanzer teaches that item 100 is the carrier layer. Applicant can find no passage in Tanzer

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teaching the carrier layer (100) as being a hot melt adhesive. As a result, the Office has failed to establish a *prima facie* case for Claim 3.

With regard to Claims 7 and 12, the Office states:

[M]ere changes in size alone are not sufficient to patentably distinguish an invention over the prior art." *In Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device. MPEP § 2144.04.

Applicant traverses the rejection on grounds originally presented in the reply dated March 7, 2006. Claims 7 and 12 are dependent from and contain all the limitations of Claim 1. Tanzer fails to teach each and every limitation of Claim 1. Therefore, Claims 7 and 12, which include all the limitations of Claim 1, are patentably distinct over Tanzer.

Furthermore, the Office cites *Gardner v. TEC Systems, Inc.* in support of the rejection. However, Applicants assert that *Gardner* is inapplicable to the present application. The *Gardner* decision is grounded upon two prerequisites. First, the only difference between the prior art and the claims is a recitation of relative dimensions of the claimed device. *Gardner*, 725 F.2d 1338, 1345 (Fed. Cir. 1984) ("Vits discloses the invention of the claims in suit except for their dimensional limitations."). As argued with regard to claim 1, the differences between Applicant's invention and Tanzer are more than a mere recitation of dimension. Second, the device having the claimed relative dimensions would not perform differently than the prior art device. Applicants assert that any limitation on the crotch width may have an adverse impact on an absorbent article. Less width results in less material that can absorb body exudates. Therefore, changing dimension may result in an article that performs differently than disclosed in Tanzer.

In light of the foregoing remarks Applicants respectfully submit that Tanzer does not teach or suggest each and every element of claim 1, and therefore does not teach or suggest each and every element of any claim depending from claim 1. Accordingly,

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Applicants respectfully request that the rejection of claims 1 - 12 under 35 U.S.C. §103(a) over Tanzer be reconsidered and withdrawn.

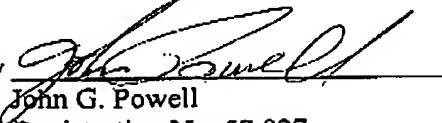
Conclusion

This response represents an earnest effort to place the application in proper form and to distinguish the invention as claimed from the cited documents. In light of the above remarks, it is requested that the Examiner reconsider and withdraw the rejection based on 35 U.S.C. § 103(a), and allow claims 1 - 20. Early and favorable action in the case is respectfully requested.

Respectfully submitted,

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Date: October 23, 2006
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